IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
    Dutta
Serial No: 09/920,522
Filed: 08/02/2001
 	
Title: USER CONTROL OF
ELECTRONIC PERSONAL
INFORMATION WHILE
BROWSING THE WEB
 	
Docket Number:
AUS920010168US1
	Before Examiner:
	    TRI V NGUYEN
	Group Art Unit: 1751
	
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APPEAL BRIEF UNDER 37 CFR §41.37

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    This Appeal Brief is submitted in support of the Appeal in the above-referenced application pursuant to a Notice of Appeal filed August 4, 2006 as required by 37 C.F.R. 41.31. This is an appeal from a final rejection dated May 4, 2006 of Claims 1-7, 9-14, 16-20, 22, and 23 of application serial number 09/920,522, filed August 02, 2001.

I. Real Party in Interest

The real party in interest in the present application is the Assignee, International Business Machines Corporation of Armonk, New York, as evidenced by the Assignment set forth at Reel 012073, Frame 0160.

II. Related Appeals and Interferences

There are no Appeals or Interferences known to Appellant, Appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. No decisions have been rendered by a court or the Board in any related applications.

III. Status of Claims

1. Status of All Claims in Application
    a. Claims Rejected: 1-7, 9-14, 16-20, 22 and 23
    b. Claims Allowed or Confirmed: None
    c. Claims Withdrawn from Consideration: None
    d. Claims Objected to: None
    e. Claims Cancelled: 8, 15, and 21
2. Claims on Appeal
    a. The claims being appealed are: 1-7, 9-14, 16-20, 22, and 23
    b. The claims being appealed stand finally rejected as noted by the Examiner in the Examiner's Action dated May 4, 2006. These rejected claims which form the basis of this appeal are reproduced in the attached Appendix.

IV. Status of Amendments

The Examiner finally rejected claims 1-7, 9-14, 16-20, 22, and 23 in a Final Office Action dated May 4, 2006. Appellants filed an amendment after final office action on August 1, 2006 requesting entry of amendments to claims 7, 9, 16, and 22. In an advisory action dated August 9, 2006, the Examiner entered the amendments to claims 7, 9, 16, and 22 and maintained the rejection of claims 1-7, 9-14, 16-20, 22, and 23.

V. Summary of Claimed Subject Matter

Claim 1 is directed to a method for controlling personal information of a user using a client computer system enabled to be communicatively connected to a plurality of network entities in a network environment. (Specification, paragraphs 0019). Personal information of the user is stored at the client computer system. (Specification, paragraphs 0019, 0039, Figure 3, element 300). A request is received from a first network entity to send the personal information stored at the client to at least one other network entity. (Specification, paragraphs 0019, 0040, 0047, Figure 4a, element 400, Figure 5, element 524). The at least one other network entity is enabled to be selectable by the user. (Specification, paragraphs 0019, 0041, Figure 4a). The personal information is enabled to be edited. (Specification, paragraphs 0039, 0041, 0042, 0048, Figure 3, element 321, Figure 4a). The edited personal information is sent from the client computer system to each of the selected ones of the at least one other network entity. (Specification, paragraphs 0043, 0048, Figure 4a, element 422, Figure 5, element 516).

Claim 2 is directed to the method of claim 1 wherein enabling the personal information to be edited is further directed to enabling the personal information to be separately edited for each selected ones of the at least one other network entity. (Specification, paragraph 0044, Figure 4a, element 421, Figure 4b).

Claim 3 is directed to the method of claim 1 and further directed to the method for watermarking the edited personal information before sending the personal information. (Specification, paragraphs 0020, 0045, 0049).

Claim 4 is directed to the method of claim 2 and further directed to the method for uniquely watermarking each one of the separately edited personal information before sending each of the separately edited personal information to each selected ones of the at least one network entity. (Specification, paragraphs 0020, 0045, 0049).

Claim 5 is directed to the method of claim 1 and further directed to the method for receiving an indication of a renumeration from the first network entity

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in response to sending the edited personal information to selected ones of the at least one network entity. (Specification, paragraphs 0019, 0050).

Claim 6 is directed to the method of claim 1 receiving a request is further directed to the method of receiving, with the request, a financial incentive to comply with the request. (Specification, paragraphs 0046, 0050).

Claim 7 is directed to a method for a web server participating in a distribution of personal information of a user in a network environment. (Specification, paragraph 0019). A web server (Figure 1, elements 11, 12, and 13) accessed by a user from a client system (Figure 1, element 4) over a network (Figure 1, element 10) receives initial personal information from the user over the network. (Specification, paragraphs 0030, 0035, 0040, 0047, Figure 5, element 521). The web server sends a request to the user requesting the user send the initial personal information of the user to at least one other specified network entity. (Specification, paragraphs 0019, 0040, 0041, 0047, Fig. 4a, element 400, Figure 5, element 524). An indication of a financial incentive to comply with the request is sent with the request. (Specification, paragraphs 0046, 0051). The web server receives a copy of the user personal information sent to the at least one other specified network entity from the user. (Specification, paragraphs 0046, 0050, Figure 5, element 525). The web server compares the received copy of the user personal information with the received initial personal information. (Specification, paragraphs 0046, 0050, Figure 5, element 526). The web server sends renumeration, based on the comparison, to the user for complying at least in part with the request. (Specification, paragraphs 0046, 0050, Figure 5, element 527).

Claim 9 is directed to the method of claim 7 and further directed to the web server receiving a first remuneration from each of the at least one other specified network entity to which the user personal information was sent. (Specification, paragraph 0051).

Claim 10 is directed to a method for participating in a distribution of personal information of a user in a network environment. (Specification, paragraph 0019) A second network entity receives personal information of the

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user from the user client system with an indication of a requesting network entity that requested the user send the second network entity the personal information. (Specification, paragraph 0051). The second network entity sends a renumeration to the indicated requesting network entity in response to receiving the personal information from the user client system. (Specification, paragraph 0051).

Claim 11 is directed to a data processing system. The data processing system comprises a communications device enabling communication over a network (Specification, paragraph 0035, Figure 2, element 210), a first memory having a set of instructions (Specification, paragraph 0031, Figure 1, element 50), a second memory having personal information of a user (Specification, paragraphs 0031, 0039, Figure 1, element 50) and a processing unit executing the set of instructions in the first memory (Specification, paragraph 0031, Figure 1, element 40) to enable receipt of a request from a first network entity through the communications device to send the personal information stored in the second memory to at least one other network entity (Specification, paragraphs 0035, 0040, 0048, Figure 5, element 512), to enable the at least one other network entity to be selectable by the user (Specification, paragraphs 0041, 0048), to enable the personal information to be edited (Specification, paragraphs 0042, 0044, 0048, Figure 5), and to send the edited personal information to each of the selected ones of the at least one other network entity (Specification, paragraph 0043, 0048, Figure 5, element 516).

Claims 12 and 13 are directed to a computer system enabled to be communicatively connected to a plurality of network entities in a network environment (Specification, paragraph 0030) and having means for performing the elements described in claims 1 and 3 (Specification, paragraph 0031).

Claims 14 and 16 are directed to a computer system enabled to be communicatively connected to a plurality of network entities in a network environment (Specification, paragraph 0030) and having means for performing the elements described in claims 7 and 9 (Specification, paragraph 0031).

Claim 17 is directed to a computer system enabled to be communicatively connected to a plurality of network entities in a network environment. (Specification, paragraph 0030). The computer system has a network entity communicatively connected within the network, the network entity having means for performing the elements described in claim 10. (Specification, paragraphs 0030, 0031).

Claims 18 and 19 are directed to a computer program on a computer usable medium having computer readable program code means for performing the steps described in claims 1 and 3. In particular, the specification describes a recording medium with means recorded on the recording medium for performing the elements of claims 18 and 19 in the Specification, paragraphs 0031 and 0054. Examples of a computer usable medium include, but are not limited to "...nonvolatile media, hard-coded type mediums such as CD-ROMs, DVDs, read only memories (ROM) or erasable, electronically programmable read only memories (EEPROMs), recordable type mediums such as floppy disks, hard disk drives and CD-RW and DVD-RW disks, and transmission type mediums such as digital and analog communication links, or any signal bearing media." (Specification, paragraph 0054).

Claims 20 and 22 are directed to a computer program on a computer usable medium having computer readable program code means for performing the steps described in claims 7 and 9. In particular, the specification describes a recording medium with means recorded on the recording medium for performing the elements of claims 20 and 22 in the Specification, paragraphs 0031 and 0054. Examples of a computer usable medium include, but are not limited to "...nonvolatile media, hard-coded type mediums such as CD-ROMs, DVDs, read only memories (ROM) or erasable, electronically programmable read only memories (EEPROMs), recordable type mediums such as floppy disks, hard disk drives and CD-RW and DVD-RW disks, and transmission type mediums such as digital and analog communication links, or any signal bearing media." (Specification, paragraph 0054).

Claim 23 is directed to a computer program on a computer usable medium

having computer readable program code means for performing the steps described in claim 10. In particular, the specification describes a recording medium with means recorded on the recording medium for performing the elements of claim 23 in the Specification, paragraphs 0031 and 0054. Examples of a computer usable medium include, but are not limited to "…nonvolatile media, hard-coded type mediums such as CD-ROMs, DVDs, read only memories (ROM) or erasable, electronically programmable read only memories (EEPROMs), recordable type mediums such as floppy disks, hard disk drives and CD-RW and DVD-RW disks, and transmission type mediums such as digital and analog communication links, or any signal bearing media." (Specification, paragraph 0054).

VI. Grounds of Rejection to be Reviewed on Appeal

1. Claims 1, 2, 5, 6, 11, 12, 16, and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Goldhaber (US Patent 5,855,008).

2. Claims 10, 17, and 23 stand rejected under 35 U.S.C. §102(b) as being anticipated by Karp et al (2003/0154171).

3. Claim 3, 4, 13, and 19 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable under Goldhaber (US Patent 5,855,008) in view of O'Neil (US Patent 5,987,440).

4. Claims 7, 9, 14, 16, 20, and 22 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable under Goldhaber (US Patent 5,855,008).

VII. Argument

1. 35 U.S.C. 102(b), Alleged Anticipation, Claims 1, 2, 5, 6, 11, 12, 16, and 18

The Final Office Action rejects claims 1, 2, 5, 6, 11, 12, 16, and 18 under 35 U.S.C. §102(b) as being allegedly anticipated by Goldhaber (US Patent 5,855,008). [Final Office Action, p. 3] The rejection is respectfully traversed as follows. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksma*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because Goldhaber does not teach each and every element of claims 1, 2, 5, 6, 11, 12, 16, and 18 or enable each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

Claims 1, 11, 12, and 18

Claim 1, which is representative in rejection to claims 11, 12, and 18, reads as follows:

> 1.   A method for controlling personal information of a user using a client computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising:
>   storing personal information of the user at the client computer system;
>   receiving a request from a first network entity to send the personal information stored at the client to at least one other network entity;
>   enabling the at least one other network entity to be selectable by the user;
>   enabling the personal information to be edited; and
>   sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity.

Appellants respectfully assert that Goldhaber does not teach or enable
each and every element of claim 1 because Goldhaber does not teach or enable
receiving a request from a first network entity to send the personal information
stored at the client to at least one other network entity or sending the edited
personal information from the client computer system to each of the selected
ones of the at least one other network entity, both of which the Office Action cites
as described in Goldhaber, col. 7, lines 11-67. [Final Office Action, p. 3]

In general, Goldhaber describes "an approach for distributing advertising
and other information over a computer network." *Goldhaber*, abstract.
Goldhaber describes an "attention brokerage" system or service that provides the
"link between the ad and the appropriate viewer" where the "attention brokerage"
system providing the link maintains a database of profiles of potential viewers
and "protects member privacy while at the same time maintaining the personal
information files that permit specialized targeting of ads." *Goldhaber*, col. 6, lines
28-35. Col. 7, lines 11-17 of Goldhaber describes the "attention brokerage"
system implements

> "a two step technique for the development of an accurate consumer
> profile. First, a consumer is asked to pro-actively describe him or
> herself. This forms a "base profile." Then the consumer's actions
> can be monitored in this example such that a representation of the
> consumer's actions are "overlaid" upon the self description."

Col. 7, lines 28-32 of Goldhaber describe that "upon logging into her customized
home page, Cynthia would be presented with a list of ads that she may elect to
view. The ads would be preselected for her on the basis of a personal profile
questionnaire that she has completed plus automatic tracking of her previous
internet usage." In addition, Col. 7, lines 48-67 of Goldhaber describe:

> Next to some of the titles on the ad list displayed to Cynthia
> is the image of a little gold coin--a "consumer interface button" or
> "CyberCoin"--with a distinctive style. When Cynthia clicks her
> mouse on the CyberCoin, it opens up the ad and simultaneously
> causes a transfer of cash or credit directly to Cynthia's desktop (or
> to a specialized account, credit card or bank account associated
> with her). This gives Cynthia an important incentive to watch the ad.
> The ad can include some degree of interactivity (e.g., Forty-Niners

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game stadium seating preference, choice of diet dessert, etc.) to
allow the service to give the advertiser a guarantee that Cynthia
paid attention to the ad. This interactivity can make the ad more fan
(e.g., by providing a guessing game, quiz or joke).

The ad might ask Cynthia if she is interested in having the
merchant contact her directly, and can include another CyberCoin
that compensates Cynthia for the informing the merchant of her
identity. Cynthia can be given the choice of whether her identity is
to be released--thereby protecting her privacy.

In contrast to Goldhaber, Appellants respectfully assert that when claim 1
is viewed as a whole, claim 1 teaches each of a client computer system, a first
network entity, and at least one other network entity. The personal information is
stored at the client computer system. The client computer system receives a
request from a first network entity to send the personal information to at least one
other network entity. The personal information is sent from the client computer
system to the at least one other network entity. Appellants respectfully assert
that the arguments as to Goldhaber reading on claim 1 are flawed because the
Final Office Action does not state a ground of rejection that distinguishes
between or reads on each of a client computer system, a first network entity and
at least one other network entity as taught by claim 1.

First, with respect to the example in col. 7 of Goldhaber, Appellants
respectfully assert that where Goldhaber describes a user "logging into her
customized home page", Goldhaber describes the interface for the user logging
into the "attention brokerage" system, which is a first network entity. Goldhaber
only describes the attention broker system that accesses and stores a personal
profile for a user and sends the personal profile to advertisers if authorized, by
the user; Goldhaber does not teach a client system that receives a request from
an attention broker system for the client system to send personal information
stored at the client system to advertisers. In contrast, claim 1 teaches receiving
a request at the client system from the first network entity to send personal
information to at least one other network entity and sending the information from
the client system to the at least one other network entity.

Second, even if, as asserted in the Final Office Action, the login web page were considered the first network entity and the "attention brokerage" system another network entity, the web page would then be an interface for passing information to the "attention brokerage" system. Therefore, even under the Examiner's assertions, Goldhaber still does not teach each element of claim 1 where the Office Action asserts that the attention broker system reads on the other network entity because Goldhaber does not teach or enable sending the personal information stored at the client system directly from the client system to the attention brokerage system.

Goldhaber, col. 12, lines 50-67, as cited in the Final Office Action, describes an example statement that the attention brokerage system displays to the user to give notice that once the user provides the attention brokerage system with personal information, the service will not release the information to an advertiser unless the user authorizes the service to send the information. Thus, col. 12, lines 50-67 of Goldhaber confirm that the attention brokerage system is the system that passes personal information to advertisers; Goldhaber does not teach the client system receiving a request from the attention brokerage system for the client system to send the personal information to another network entity.

In addition, col. 19, lines 22-67 of Goldhaber describes network accessible "trading houses" that attempt to sell information to willing buyers. Goldhaber describes that the consumer has a software agent at the client system that stores the user's personal information and is programmed to determine which trading houses have advertising that matches the user's instructions and to retrieve the matching advertising from the associated trading house. Thus, even in the "trading houses" model of Goldhaber, the client system does not store the personal information and therefore the client system also does not receive a request from a first network entity to send the stored information to at least one other network entity or send the information from the client system to at least one other network entity.

In the response to arguments in the Final Office Action, the Examiner responds to Appellants assertions by noting that "Goldhaber et al discloses that advertisers (one or more network entities) can request personal information from the Attention Brokerage system (different one or more network entities, such as a server or a user's computer) and that the user is allowed to select the advertisers, edit "his profile at any time" and give consent on "case-by-case" basis." (col., 6, line 50 to col. 7, line 10, col. 12, line 48 to col. 13, line 52, and col. 14, lines 48-60). [Final Office Action, p. 8] These additional arguments, presented in the Final Office Action, are also flawed. Col. 14, lines 48-60 describes that the user's profile may be stored at the software agent running on the user's computer system. Col. 14, lines 48-60 and the accompanying figure 8, do not, however, teach or enable the client computer system sending personal information to other network entities. Instead, throughout, Goldhaber clearly describes the attention broker as filtering and passing all information between the client computer system and an advertising system.

Therefore, because Goldhaber does not teach or enable a client system with the stored personal information, a first network entity that requests that the client system send the information, and at least one other network entity that the client system sends the personal information to, Goldhaber does not teach or enable each and every element of claim 1. Because each and every element of claim 1 is not taught by Goldhaber, Goldhaber does not anticipate claim 1 and therefore claim 1 should be allowed.

In addition, as to claim 11, claim 11 is a data processing system claim including a processing unit executing a set of instructions with similar limitations of claim 1 and, therefore, is allowable for at least the same reasons as claim 1. Claim 12 is a computer system claim including means for performing similar limitations of claim 1 and, therefore, is allowable for at least the same reasons as claim 1. Claim 18 is a computer program including similar limitations of claim 1 and, therefore, is allowable for at least the same reasons as claim 1.

Claims 2, 5, and 6

Further, each of claims 2, 5, and 6 each depend, directly or indirectly, on allowable independent claim 1. Therefore, claims 2, 5, 6, and 16 are also allowable for at least the same reasons that claim 1 is allowable as discussed above.

Claim 16

As to claim 16, Appellants note that claim 16 is dependent upon claim 14, which is rejected under Goldhaber et al. under 103(a). [Final Office Action, p. 6] Appellants respectfully assert that because claim 14 is allowable, as will be asserted below, claim 16, which depends directly on independent claim 14, is also allowable for at least the same reasons that claim 14 is allowable.

2.   35 U.S.C. 102(b), Alleged Anticipation, Claims 10, 17, and 23

The Final Office Action rejects claims 10, 17, and 23 under 35 U.S.C. §102(b) as being allegedly anticipated by Karp et al (2003/0154171). [Final Office Action, p. 4] Appellants respectfully assert that claims 10, 17, and 23 are not anticipated by Karp et al. and therefore should be allowed.

The Final Office Action rejects the elements of <u>receiving, at a network entity, personal information of the user from the user client system with an indication of a requesting network entity that requested the user send the network entity the personal information</u> and <u>sending, from the network entity, a remuneration to the indicated requesting network entity in response to receiving the personal information from the user client system</u> based on Karp et al., page 2, paragraphs 0025 and 0027. [Final Office action, p. 4]

Karp et al., paragraphs 0025 and 0027 describes a trusted third party that manages the distribution of information about a user to a requestor. In Karp et al, paragraphs 0025 and 0027, an information source holds the information about the user and the requester receives the information from the trusted third party. Karp et al., paragraph 0026 describes that the trusted third party determines whether to distribute the information to the requestor based on a policy, which

may include the cost of the information. Karp et al., paragraph 0028 describes that the requestor provides payment for the information to the trusted third party.

While Karp et al. paragraphs 0025 and 0027 describe that the requestor is a network entity that may receive information from a trusted third party and may send renumeration to the trusted third party, Karp et al. does not teach that the requester receives the personal information from the user client system, as taught in claim 10. In addition, Karp et al. describes that the requestor requests the information; Karp et al. does not teach that the requestor receives the personal information with an indication of a separate requesting network entity that requested the user send the requestor the personal information, as taught in claim 10. Further, Karp et al. describes that the requestor sends the renumeration to the trusted third party; Karp et al. does not teach that the requestor sends the renumeration to the network entity that requested that the user send the personal information from the client system, as taught in claim 10. Therefore, in view of the foregoing, Karp et al. does not teach or enable each of the network entity, a separate requesting network entity, and a separate user client system as specifically taught in claim 10. Because Karp et al. does not teach each and every element of claim 10, Karp et al. does not anticipate claim 10 and the claim is allowable over Karp et al.

In addition, as to claim 17, claim 17 is a system claim with similar limitations of claim 10 and, therefore, is allowable for at least the same reasons as claim 10. Claim 23 is a computer program including similar limitations of claim 10 and, therefore, is allowable for at least the same reasons as claim 10.

3.   35 U.S.C. 103(a), Alleged Obviousness, Claims 3, 4, 13, and 19

The Final Office Action rejects claim 3, 4, 13, and 19 under 35 U.S.C. §103(a) as being allegedly obvious under Goldhaber (US Patent 5,855,008) in view of O'Neil (US Patent 5,987,440). [Final Office Action, p. 5] First, claims 1, 12, and 18, upon which claims 3, 4, 13, and 19 are dependent, are not anticipated by Goldhaber and therefore the dependent claims are not obvious under Goldhaber in view of O'Neil. Separately, the Examiner does not establish

a prima facie case of obviousness as to claims 3, 4, 13, and 19, and therefore

claims 3, 4, 13, and 19 are allowable over Goldhaber in view of O'Neil.

Claims 3 and 4

Claims 3 and 4 read:

> 3.   The method of claim 1 further comprising watermarking the
> edited personal information before sending the personal
> information.

> 4.   The method of claim 2 further comprising:
> uniquely watermarking each one of the separately edited
> personal information before sending each of the separately edited
> personal information to each selected ones of the at least one
> network entity.

In the rejection of claim 3, the Final Office Action states "Goldhaber

discloses the need to prevent unauthorized release of the personal information

but does not explicitly mention the use of watermarking the edited personal

information before sending the personal information." [Final Office Action, p. 5]

The Final Office Action cites O'Neil as "an analogous art" and asserts that O'Neil

discloses "the use of digital signature to track and prevent further distribution of

personal information beyond a third party" in col. 6, lines 29-53 and col. 9, lines

27-55. [Final Office Action, p. 5] The Final Office Action concludes "it would

have been obvious to one having ordinary skill in the art at the time the invention

was made to modify the method taught by Goldhaber et a. with the use of digital

signature as taught by O'Neil since it was known in the art that a digital signature

or watermark is used to securely deliver electronic documents and information

thus preventing non-authorized distribution." [Final Office Action, p. 5]

Similarly, in the rejection of claim 4, the Final Office Action states

"Goldhaber discloses the need to prevent unauthorized release of the personal

information but does not explicitly mention the use of uniquely watermarking

each one of the separately edited personal information before sending each of

the separately edited personal information to each selected ones of the at least

one network entity," but cites O'Neil, as "analogous art" and asserts that "O'Neil

teaches the use of digital signature to track and prevent further distribution of personal information beyond a third party" in col. 6, lines 29-53 and col. 9, lines 27-55. [Final Office Action, p. 5]

Col. 6, lines 29-53 of O'Neil read:

The other aspect of trusted processing, protection of data, is improved in two ways by the preferred embodiment of the present invention. First, the preferred embodiment uses state-of-the-art techniques, such as public-key cryptography, to securely store and transmit information. Public-key cryptography is discussed in more detail in a later section. These techniques assure that the data can not be deciphered if intercepted during transmission, and only the intended reader can decrypt and understand the information. The second security feature of the preferred embodiment is designed to place controls on the amount of information processed and to limit the utilization of data to recipients meeting criteria established by the user. This security feature allows the user to set rules that govern the processing and utilization of personal information. For example, one rule may state that it is acceptable to release legal history information to a user that is from the American Bar Association E-Metro Community. Another rule may state it is acceptable to utilize a home phone number by a user that is single, from a particular geographic area, and also agrees to have their home number utilized in a controlled manor. By setting sufficient rules, an individual can control the utilization of personal information by only trusted users. Additionally, the user may set transitive rules that attach to information that control electronic distributed processing of the information. Thus, when a user authorizes trusted remote processing of personal information, the information is utilized in a manner that allows the user to maintain command and control of how the information is subsequently utilized.

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Appellants respectfully assert that the Examiner fails to prove a prima facie case of obviousness in claims 3 and 4 and therefore Appellants respectfully request withdrawal of the rejection and allowance of the claims.

Goldhaber in view of O'Neil does not teach or suggest each and every element

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In*

re Vaeck, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Appellants respectfully assert that a prima facie case of obviousness is not proven because Goldhaber in view of O'Neil fails to teach or suggest all the elements of claims 3 and 4. In particular, Appellants respectfully assert that Goldhaber in view of O'Neil does not teach or suggest each and every element of claims 3 and 4 because O'Neil does not teach or suggest watermarking the edited personal information before sending the information to at least one other network entity.

O'Neil only describes use of a digital signature to encrypt data for secure transmission. *O'Neil*, col. 6, lines 29-53. In contrast, a digital signature, which encrypts data for secure transmission, does not teach or suggest a digital watermark, which is data embedded in a file to identify ownership. During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and "customary" meaning of the terms of the claims; the ordinary and customary meaning of terms may be evidenced in dictionaries and treatises. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003); *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2s 1812. Appellants respectfully assert that when claims 3 and 4 are given their broadest reasonable interpretation consistent with the specification and in view of the dictionary meanings of "digital watermark" and "digital signature" which establishes an "ordinary" and "customary" meaning for each of these terms, it is clear that O'Neils' digital signature does not teach or suggest the digital watermark of claims 3 and 4.

In particular, Appellants respectfully assert that in examining claims 3 and 4 with the broadest reasonable interpretation consistent with the specification

and consistent with the interpretation that those skilled in the art would reach, it is clear that a "digital signature", which encrypts data for secure transmission, does not teach or suggest a "digital watermark", which is data embedded in a file to identify origin and ownership. The terms "digital signature" and "digital watermark" have plain meanings that clearly show that applying a digital signature does not teach or suggest applying a digital watermark. Digital signature is defined as "a security mechanism used on the Internet that relies on two keys, one public and one private, that are used to encrypt messages before transmission and to decrypt them on receipt." Microsoft Computer Dictionary, 5th Edition, copyright Microsoft Corporation 2002, p. 159. Digital watermark is defined as "a unique identifier embedded in a file to deter piracy and prove file ownership and quality. Digital watermarking is often used with graphics and audio to identify the owner's rights to these works." Microsoft Computer Dictionary, 5th Edition, copyright Microsoft Corporation 2002, p. 160. The specification of the present application supports an interpretation of the term "watermarking" in line with the dictionary definition. *Specification*, paragraph 0045 ("...The watermark may include any type of watermarking including special textual content, background graphics, or subliminal watermarks that are invisible to the human eye. Another type of watermarking may include varying the format or content of various fields within the personal information such as changing the format of the address...")

Therefore, because a digital signature and a digital watermark are different types of digital protection Appellants respectfully assert that O'Neil's system of digital signatures to encrypt data to ensure that only those recipients with a key can open the transmission does not teach the limitation of claims 3 and 4 of watermarking personal information by embedding unique data into the personal information so that the particular transmission of the personal information is uniquely identified.

In addition, Appellants note that in the remarks portion of the Final Office Action, the Examiner states that "it is known in the art that one of the use of digital signature is as a digital watermark to ensure that the critical information

(such as personal information) can be tracked. The teaching of O'Neil regarding the digital signature that is attached to a document as a security tool in transmitting documents electronically over a network is applicable to "watermarking" a document for transmission over the Web as set forth in pages 15 and 16 of the present specification (in particular the Applicant is silent as to a special definition of watermarking)." [Final Office Action, pp. 8-9] This assertion, however, merely states that watermarking has a well known meaning of incorporating digital signatures, but does not provide any support for this assertion. Appellants do not assert now and have not asserted in the past that the present application teaches a "special definition" of watermarking, but have presented arguments indicating that the ordinary meanings of digital signatures and digital watermarking known in the art are **different**, not incorporating one another and that the examples of watermarking specifically defined in the specification are in line with the customary meanings of these terms to one with knowledge in the art.

There is no suggestion or motivation to modify Goldhaber by O'Neil to teach or suggest each and every element

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the references. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). In particular, the teaching, suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d

1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Appellants respectfully assert that the Examiner's proposed modification of O'Neil and then Goldhaber by O'Neil is an improper use of "hindsight" occasioned only by Appellants' own teachings.

The Examiner's modification of references to teach all the elements of claims 3 and 4 would require first modifying O'Neil's description of applying digital signatures to applying digital watermarking. Neither O'Neil nor the Examiner's rejection points a motivation or suggestion for modifying digital signatures to teach digital watermarking.

Next, the Examiner's modification of references would require modifying Goldhaber's description of the attention broker system that distributes personal information to further include the modified system of O'Neil. Goldhaber does not motivate or suggest uniquely identifying a particular transmission of the personal information by the attention broker server. In addition, neither O'Neil nor the Examiner's rejection point to a motivation or suggestion for modifying Goldhaber's system to teach a client system that watermarks edited personal information before sending the information from the client system to the at least one other network entity.

Therefore, in view of the Examiner's rejection requiring a modification of O'Neil to teach digital watermarking and then a modification of Goldhaber to teach applying watermarking to personal information whether neither O'Neil nor Goldhaber suggest or motivate these modifications, it is apparent that the rejection is only based on an improper use of "hindsight" occasioned by Appellants' own teachings. Because there is no motivation or suggestion to combine Goldhaber by O'Neil to teach each and every element of claims 3 and 4, a prima facie case of obviousness is not proven and the claims should be allowed.

Claims 17 and 19

In addition, as to claim 17, claim 17 is a dependent system claim with similar limitations of claim 3 and, therefore, is allowable for at least the same reasons as

claim 3. Claim 19 is a dependent computer program claim including similar limitations of claim 3 and, therefore, is allowable for at least the same reasons as claim 3.

4.   35 U.S.C. 103(a), Alleged Obviousness, Claims 7, 9, 14, 16, 20, and 22

The Final Office Action rejects claims 7, 9, 14, 16, 20, and 22 under 35 U.S.C. §103(a) as being allegedly obvious under Goldhaber et al. (US Patent 5,855,008). [Final Office Action, p. 6] The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection.

Claims 7, 14, and 20

The Final Office Action cites Goldhaber as teaching the elements of claim 7 of <u>receiving, at a web server accessed by a user from a client system over a network, initial personal information from the user over the network</u> and <u>sending a request from the web server to the user requesting the user send the initial personal information of the user to at least one other specified network entity</u> at col. 9, lines 53-67 and <u>sending, with the request, an indication of a financial incentive to comply with the request</u> at col. 16, lines 12-24 and col. 12, lines 49-67. [Final Office Action, p. 6]

As to the elements of (1) <u>receiving, at the web server, a copy of the user personal information sent to the at least one other specified network entity from the user, comparing, at the web retailer</u>, (2) <u>the received copy of the user personal information with the received initial personal information</u>, and (3) <u>sending a renumeration, based on the comparison, from the web server to the user for complying at least in part with the request</u>, the Final Office Action states that Goldhaber does not explicitly disclose these elements. [Final Office Action, p. 6] As to these elements, the Examiner states:

> "Goldhaber et al. discloses the use of Trading Houses implemented on a network on a network for facilitating transactions between the buyer and the seller and matching the records from both parties, allowing the seller to directly contact the buyer and sending a renumeration (col. 19, line 20 to col. 20, line 57). Furthermore

Goldhaber et al. teaches checking and monitoring that the user has performed a requested action prior to dispensing a renumeration (col. 16, lines 12-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldhaber et al. with checking that the information sent to a buyer since it was known in the art that following up on a transaction between a first and second part by a third party is used to ensure that the terms of the specific transaction were met and thus allowing for the proper renumeration to be disbursed." [Final Office Action, p. 7]

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Appellants respectfully assert that the Examiner fails to prove a prima facie case of obviousness in claim 7 and therefore Appellants respectfully request withdrawal of the rejection and allowance of the claims.

Goldhaber as modified by the Examiner does not teach or suggest each and every element

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Appellants respectfully assert that a prima facie case of obviousness is not proven because Goldhaber as modified fails to teach or suggest all the elements of claim 7.

First, Goldhaber as modified does not teach or suggest <u>sending a request from the web server to the user requesting the user send the initial personal information of the user to at least one other specified network entity</u>. *Goldhaber*, col. 9, lines 53-67 describes the attention broker sending a request to the user to approve distributing the user's personal information to an advertiser. Goldhaber does not teach sending a request from the attention broker to the user requesting that the user send the personal information to the other network entity. In addition, the proposed modifications to Goldhaber do not teach the web server sending a request to the user requesting that the user directly send the personal information to at least one other specified network entity. Therefore, because Goldhaber does not teach or suggest sending a request to the user for the user to directly send the user's personal information to another specified network entity, Goldhaber does not teach or suggest each and every element of claim 7.

Second, Goldhaber as modified does not teach the element of <u>sending a renumeration, based on the comparison, from the web server to the user for complying at least in part with the request</u>. The attention broker of Goldhaber only describes sending renumeration to an account that the attention broker maintains for the user, at the attention broker system. *Goldhaber*, col. 16, lines 12-23. The trading house of Goldhaber describes that the user may send renumeration to the trading house system, in return for the information being sold to the user. *Goldhaber*, col. 19, line 63 through col. 20, line 9. Neither of the attention broker or trading house of Goldhaber teaches or suggests sending the renumeration from the web server (attention broker) to the user client system. Further, the Final Office Action does not address this element in the modification statement. Therefore, because Goldhaber does not teach or suggest sending a renumeration from the web server to the user for complying at least in part with the request, Goldhaber does not teach or suggest each and every element of claim 7.

Because Goldhaber does not teach or suggest each and every element of claim 7, a prima facie case of obviousness is not established for claim 7 and the claim is allowable over Goldhaber as modified.

There is no suggestion or motivation to modify Goldhaber to teach or suggest each and every element

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the references. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). In particular, the teaching, suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claims. *In*

re Surko, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Appellants respectfully assert that the proposed modifications require multiple modifying steps, none of which are motivated or suggested by the reference or the knowledge of one with skill in the art. Because there is no motivation or suggestion for the multiple modifications the proposed modification of Goldhaber is an improper use of "hindsight" occasioned only by Appellants' own teachings.

First, the Final Office Action cites Goldhaber's description of a trading house as describing the ability for a client system to communicate with the advertiser, directly, without a brokering system and therefore as reading on a user sending personal information directly to the specified network entity. [Final Office Action, p. 7] The Final Office Action cites Goldhaber's brokering system, however, as reading on the client system/web server relationship. [Final Office Action, p. 7] Thus, to modify Goldhaber to teach the claimed invention, first, Goldhaber's brokering system must be modified to incorporate Goldhaber's trading house system. There is not a suggestion for the proposed modification.

In particular, in the example of the trading house of Goldhaber, col. 19, lines 22-67 describes network accessible "trading houses" that attempt to sell information to willing buyers. Goldhaber, col. 19, lines 22-67 describes that the consumer has a software agent at the client system that stores the user's personal information and is programmed to directly contact each trading house system, to determine which trading houses have advertising that matches the user's instructions, and to retrieve the matching advertising from the associated trading house. Thus, in the trading houses model, there is no need for a brokering system and there is direct accountability between the buyer and the seller; there is not a separate broker connecting the buyer and the seller. In contrast, the purpose of the attention broker of Goldhaber is to broker the

passage of information between the buyer and the seller. Therefore, the attention broker of Goldhaber teaches against modification to enable the client system and the advertising system to directly contact one another because the attention broker controls all communications, and maintains the privacy of the client unless authorized to release selected information to the advertiser. Because there is no motivation or suggestion to modify the attention broker of Goldhaber by the trading house system of Goldhaber, there is no motivation or suggestion for modifying Goldhaber to teach the web server of claim 7.

Second, the Final Office Action cites Goldhaber's as describing "checking and monitoring that the user has performed a requested action prior to dispensing renumeration in col. 16, lines 12-23. [Final Office Action, p. 7] Col. 16, lines 12-23, however, specifically describe that if a consumer chooses to view an advertisement, from the attention broker, that the advertisement display sent by the attention broker may "ask the consumer questions or otherwise require consumer interaction to ensure the consumer has paid attention to the advertisement." Thus, Goldhaber specifically describes the attention broker monitoring the consumer's interaction, at the client system, with an advertisement. Merely because Goldhaber describes monitoring the user's interaction with information at the client system does not suggest modification of the attention broker to further monitor and verify communications between the user and the advertiser. Adding this feature would change the purpose of the attention broker to a purpose that is not suggested in Goldhaber.

Therefore, because there is no motivation or suggestion for modifying the attention broker and the trading houses of Goldhaber to teach all the elements of claim 7 within Goldhaber or the knowledge of one with skill in the art, a prima facie case of obviousness is not established as to claim 7 and the claim should be allowed.

Claim 14 is system claim including similar limitations and rejections as claim 7, and therefore, is allowable for at least the same reason as claim 7.

Claim 20 is a computer program claim including similar limitations and rejections as claim 7, and therefore, is allowable for at least the same reason as claim 7.

Claims 9, 16, and 22

Further, each of claims 9, 16, and 22 each depend, directly or indirectly, on allowable independent claims 7, 14, and 20. Therefore, claims 9, 16, and 22 are also allowable for at least the same reason that claims 7, 14, and 20 are allowable as discussed above.

CONCLUSION

It is therefore respectfully requested that the Examiner's rejection of claims 1-7, 9-14, 16-20, 22, and 23 under 35 USC 102(e) be reversed and the claims allowed.

Please charge the fee of $500.00 for submission of an Appeal Brief under 37 CFR 41.20(b)(2) to IBM Corporation Deposit Account No. 09-0447. No additional filing fee is believed to be necessary; however, in the event that any additional fee is required, please charge it to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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VIII. Claims Appendix

The Claims involved in the Appeal are as follows:

1.   A method for controlling personal information of a user using a client computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising:

storing personal information of the user at the client computer system;

receiving a request from a first network entity to send the personal information stored at the client to at least one other network entity;

enabling the at least one other network entity to be selectable by the user;

enabling the personal information to be edited; and

sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity.

2.   The method of claim 1 wherein enabling the personal information to be edited further comprises enabling the personal information to be separately edited for each selected ones of the at least one other network entity.

3.   The method of claim 1 further comprising watermarking the edited personal information before sending the personal information.

4.   The method of claim 2 further comprising:

uniquely watermarking each one of the separately edited personal information before sending each of the separately edited personal information to each selected ones of the at least one network entity.

5.   The method of claim 1 further comprising receiving an indication of a remuneration from the first network entity in response to sending the edited personal information to selected ones of the at least one network entity.

6.   The method of claim 1 wherein receiving a request further comprises receiving, with the request, a financial incentive to comply with the request.

7.   A method of a web server participating in a distribution of personal information of a user in a network environment, comprising:

receiving, at a web server accessed by a user from a client system over a network, initial personal information from the user over the network;

sending a request from the web server to the user requesting the user send the initial personal information of the user to at least one other specified network entity;

sending, with the request, an indication of a financial incentive to comply with the request;

receiving, at the web server, a copy of the user personal information sent to the at least one other specified network entity from the user;

comparing, at the web server, the received copy of the user personal information with the received initial personal information; and

sending a renumeration, based on the comparison, from the web server to the user for complying at least in part with the request.

9.   The method of claim 7 further comprising:

receiving, at the web server, a first remuneration from each of the at least one other specified network entity to which the user personal information was sent.

10.   A method of participating in a distribution of personal information of a user in a network environment, comprising:

receiving, at a second network entity, personal information of the user from the user client system with an indication of a requesting network entity that requested the user send the second network entity the personal information; and

sending, from the second network entity, a remuneration to the indicated requesting network entity in response to receiving the personal information from the user client system.

11.   A data processing system, comprising:

a communications device enabling communication over a network;

a first memory having a set of instructions;

a second memory having personal information of a user;

a processing unit executing the set of instructions in the first memory to enable receipt of a request from a first network entity through the communications device to send the personal information stored in the second memory to at least one other network entity; to enable the at least one other network entity to be selectable by the user; to enable the personal information to be edited; and to send the edited personal information to each of the selected ones of the at least one other network entity.

12.   A computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising:

means for storing personal information of a user;

means for receiving a request from a first network entity to send the stored personal information to at least one other network entity;

means for enabling the at least one other network entity to be selectable by the user;

means for enabling the personal information to be edited; and

means for sending the edited personal information to each of the selected ones of the at least one other network entity.

13.   The system of claim 12 further comprising means for watermarking the edited personal information before sending the personal information.

14.   A computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising:

means for receiving initial personal information from a user from a client system over a network;

means for sending a request to the user at the client system requesting the user to send the initial personal information of the user to at least one other specified network entity from the client system;

means for sending, with the request, an indication of a financial incentive to comply with the request; and

means for receiving a copy of the user personal information sent from the client system to the at least one other specified network entity from the user.

means for comparing the received copy of the user personal information with the received initial personal information; and

means for sending a renumeration, based on the comparison, to the user for complying at least in part with the request.

16.   The computer system of claim 14 further comprising:

means for receiving a second remuneration from each of the at least one other specified network entity to which the user personal information was sent.

17.   A computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising:

a network entity communicatively connected within the network comprising means for receiving personal information of a user from the user client system via the network with an indication of a requesting network entity that requested the user send the network entity the personal information; and means for sending a remuneration to the indicated requesting network entity in response to the received personal information.

18.   A computer program having computer readable instruction code means on a computer usable medium, comprising:

instruction means enabling a storing of personal information of a user;

instruction means enabling receipt of a request from a first network entity to send the stored personal information to at least one other network entity;

instruction means for enabling the at least one other network entity to be selectable by the user;

instruction means for enabling the personal information to be edited; and

instruction means for sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity.

19.   The computer program of claim 18 further comprising instruction means for watermarking the edited personal information before sending the personal information.

20.   A computer program having computer readable instruction code means on a computer usable medium, comprising:

    instruction means for enabling receipt of initial personal information from a user from a client system over the network;

    instruction means for sending a request to the user at the client system requesting the user to send the initial personal information of the user to at least one other specified network entity from the client system;

    instruction means for sending, with the request, an indication of a financial incentive to comply with the request;

    instruction means for enabling receipt of a copy of the user personal information sent from the client system to the at least one other specified network entity from the user;

    instruction means for comparing the received copy of the user personal information with the received initial personal information; and

    instruction means for sending a first remuneration, based on the comparison, to the user for complying at least in part with the request.

22.   The computer program of claim 20 further comprising:

    instruction means for enabling receipt of a second remuneration from each of the at least one other specified network entity to which the user personal information was sent.

23.   A computer program having computer readable instruction code means on a computer usable medium, comprising:

    instruction means for enabling receipt at a network entity communicatively connected to a network of personal information of a user from the user client system with an indication of a requesting network entity that requested the user client system send the network entity the personal information; and

    instruction means for sending a remuneration to the indicated requesting network entity in response to the received personal information from the client system.

IX. Evidence Appendix

There is no evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner that is relied upon by Appellants in the appeal.

X. Related Proceedings Appendix

There are no decisions rendered by a court or the Board in any related appeals.